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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte READE CLEMENS

Appeal No. 2008-1265
Application No. 10/718,086
Technology Center 3700

Decided: July 9, 2008

Before TERRY J. OWENS, ANTON W. FETTING and BIBHU R. MOHANTY,
Administrative Patent Judges.

OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

The Appellant appeals from a rejection of claims 1-14, which are all of the pending claims.

THE INVENTION

The Appellant claims an indenting tool and a method for making it. Claim 1 is illustrative:

1. An indenting tool comprising:
a shank having a tip end;

a diamond affixed to said tip end by a braze material,
said diamond forming a point of the tool; and

said diamond being mounted to said tip end within 8
degrees of a <17,12,24> direction.

THE REFERENCE

Anderson

US 6,051,079

Apr. 18, 2000

THE REJECTIONS

The claims stand rejected as follows: claims 1-14 under 35 U.S.C. § 112, first paragraph, enablement requirement; claims 1-6 and 8-14 under 35 U.S.C. § 102(b) over Anderson; and claim 7 under 35 U.S.C. § 103 over Anderson.

OPINION

We enter a new ground of rejection under 35 U.S.C. § 112, second paragraph, and procedurally reverse the Examiner's rejections.

New ground of rejection

Under 37 C.F.R. § 41.50(b) we enter the following new ground of rejection.

Claims 1-14 are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the Appellant regards as the invention.

The Appellant's independent claims 1, 13 and 14 require "said diamond being mounted to said tip end within 8 degrees of a <17,12,24> direction" (claim 1), "said wear resistant orientation being within 8 degrees of a <17,12,24> direction" (claim 13), and "positioning said diamond in a wear resistant orientation of within 8 degrees of a <17,12,24> direction" (claim 14).

The Appellant's total disclosure regarding the <17,12,24> direction is (Spec. ¶ 19):

A very desirable super wear-resistant indenting performance can be achieved by mounting the diamond in the $\langle 17,12,24 \rangle$ direction shown in FIG. 3 or, within 8 degrees from this direction, or within 5 degrees from this direction, as denoted by the dotted line in FIG. 3.

That figure shows a triangle having one side divided into 7 length units, one side divided into 9 length units, and one side divided into 11 length units. The vertices of the triangle are labeled “ $\langle 001 \rangle$ ”, “ $\langle 101 \rangle$ ” and “ $\langle 111 \rangle$ ”. Those symbols appear to represent crystal planes that intersect, respectively, one, two and three axes.¹ A point inside the triangle in figure 3 is labeled “ $\langle 17,12,24 \rangle$ ”, and a dashed circle is drawn around that point.

The Appellant argues (Reply Br. 3):

[O]ne of ordinary skill in the art would know $\langle 17,12,24 \rangle$ refers to 17 units of length in the x direction, 12 units of length in the y direction, and 24 units in the z direction. Nothing more is needed. Similarly, one of ordinary skill in the art would know that the diamond is aligned along the axis 24.

It is not apparent from the Appellant’s figure 3 whether the $\langle 17,12,24 \rangle$ direction is that argued by the Appellant. Nor does the Appellant’s disclosure indicate that, as argued by the Appellant, it is the diamond’s z axis that is aligned with the shank’s tip.

Thus, evidence as to the meaning of the above-cited limitations in the Appellant’s independent claims is needed. The Appellant’s above-quoted argument is merely unsupported argument by the Appellant’s counsel, and such attorney argument cannot take the place of evidence. See *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984); *In re Payne*, 606 F.2d 303, 315 (CCPA 1979); *In*

¹ See Stanley Wolf and Richard N. Tauber, *Silicon Processing for the VLSI Era, Volume 1: Process Technology* 1-5 (Lattice Press, 2nd ed. 2000).

re Greenfield, 571 F.2d 1185, 1189 (CCPA 1978); *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974).

The Appellant's claims 1-14, therefore, fail to comply with the 35 U.S.C. § 112, second paragraph, claim clarity requirement.

In some instances it is possible to make a reasonable, conditional interpretation of claims adequate for the purpose of resolving patentability issues to avoid piecemeal appellate review. In the interest of administrative and judicial economy, this course is appropriate wherever reasonably possible. *See Ex parte Saceman*, 27 USPQ2d 1472, 1474 (Bd. Pat. App. & Int. 1993); *Ex parte Ionescu*, 222 USPQ 537, 540 (Bd. App. 1984). In other instances, however, it may be impossible to determine whether or not claimed subject matter is anticipated by or would have been obvious over references because the claims are so indefinite that considerable speculation and assumptions would be required regarding the meaning of terms employed in the claims with respect to the scope of the claims. *See In re Steele*, 305 F.2d 859, 862 (CCPA 1962).

For the reason discussed above, we consider the Appellants' claims to be sufficiently indefinite that determination of enablement or application of the prior art to the claims is not possible. On this basis, we do not sustain the rejections under 35 U.S.C. §§ 112, first paragraph, enablement requirement, 102(b) or 103. It should be understood that this reversal is not a reversal on the merits of the rejections but, rather, is a procedural reversal predicated upon the indefiniteness of the claims.

DECISION

The rejections of claims 1-14 under 35 U.S.C. § 112, first paragraph, enablement requirement, claims 1-6 and 8-14 under 35 U.S.C. § 102(b) over

Appeal 2008-1265
Application 10/718,086

Anderson, and claim 7 under 35 U.S.C. § 103 over Anderson are procedurally reversed. Under 37 C.F.R. § 41.50(b) a new ground of rejection has been entered.

REVERSED, 37 C.F.R. § 41.50(b)

JRG

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